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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/722,554

11/28/2003

Miki Sasaki

OKI 392

4972

23995

7590

07/03/2006

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/722,554

Applicant(s)

SASAKI ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/23/06</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 3/23/2004 is being considered by the examiner.

### ***Claim Objections***

4. Claims 1-6 are objected to because of the following informalities:

In claim 1, lines 3-4, the recitation of “to-be-retrieved” should be –to be retrieved--. The dashes should be deleted. Appropriate correction is required.

Claim 1, line 25, and claim 3, line 10, recite “thereby” which is intended use, never actually takes place, therefore renders any recitation claimed after not be given patentable weight. Claims should be amended to recite more direct and positive language such as “to”, “which”, “that”, or “converting”. Appropriate correction is required.

Claims 1-6, recite “for” in various lines, which constitute intended use, never actually takes place, therefore renders any recitation claimed after not be given patentable weight. Claims should be amended to recite more direct and positive language such as “to”, “which”, “that”, or “arranging”. Appropriate correction is required.

In claim 2, line 12, the recitation “a numerical expression” is introduced again although originally recited in claim 1 of which claim 2 depends. It is unclear to the Examiner if this is a new instant of the recitation being introduced or is this reference to the original recitation thus lacks antecedent basis. Correction is required.

Claim 3 recite “a user” in line 9 then refer to “him/her” in line 10, which is incorrect reference. The reference should be made again to “said user” or “the user”. Correction is required.

In claim 3, the recitations of “a numerical expression” and “a prefix” in various lines are introduced again although originally recited in claim 1 of which claim 3 depends. It is unclear to the Examiner if this is a new instant of the recitation being introduced or is this reference to the original recitation thus lacks antecedent basis. Correction is required.

In claim 4, line 6, the recitation “a prefix” is introduced again although originally recited in claim 1 of which claim 6 depends. It is unclear to the Examiner if this is a new instant of the recitation being introduced or is this reference to the original recitation thus lacks antecedent basis. Correction is required.

Claim 5, line, 5, recite “can be” which suggest optionally never having to take place thus the limitation following doesn’t carry patentable weight. Claims should be amended to recite affirmative language such as “is”, “are”, or “which”. Correction is required.

Depended claims 2-6, preamble recite “A numerical expression retrieving device according to claim 1” which is inaccurate. They need to be amended to recite “The numerical expression retrieving device according to claim 1” since they are narrowing the scope of Independent claim 1 and not introducing a new device as they appear to be by reciting “A”. Correction is required.

In claim 6, line 3, the recitation “a document” is introduced again although originally recited in claim 1 of which claim 6 depends. It is unclear to the Examiner if this is a new instant

of the recitation being introduced or is this reference to the original recitation thus lacks antecedent basis. Correction is required.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. That claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible result. To perform a physical transformation, the claimed invention must transform an article of physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce reproducible results. To be tangible the claimed invention must produce a practical application or real world result.

In this case the claims fail to produce tangible output or real world result to the “referring” in the claims since no storage or presentation takes place in order to realize the “completion”.

The final claimed recitation of “thereby” is intended use never having to take place thus making the claim lacks the actual functionality of “to complete”. Claims should be amended to recite an output such as actually performing the completion or outputting/presenting the results or storing the completed numerical expression.

Furthermore, there is not enough information in the specification to distinctly define the “device” as being computer implemented.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, recites the limitation "the incomplete numerical expression" in line 24. There is insufficient antecedent basis for this limitation in the claim.

Claim 2, recites the limitation "the completion" in line 5. There is insufficient antecedent basis for this limitation in the claim.

If a “numerical expression” was selected in claim 1, claim 2’s “the document” line 5 would not exist since it was omitted under the optional recitation of “OR” presented in claim 1 of which claim 2 depends. Thus, lacks antecedent basis. Correction is required.

Claim 2, recites the limitation "the completed document" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 2, recites the limitation "the inputted original document" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 2, recites the limitation "the shorted numerical expression" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claims 3, 4, and 6, recite "it" in various lines, which is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear to the Examiner what is being referenced by "it".

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01. The omitted steps with respect to applicant's specification Figure 6 are: Claim 1, lines 23, recite "to complete the incomplete expression" however there was never a mention of incomplete or shortened expression to begin with... if such where/ when did this expression was first identified and how does this completion process takes place. There appears to be missing steps related to expression definition and completion process. Clarification is required.

10. Claim 1, preamble recite "device for retrieving" is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the



functionality. The limitations following the phrase “*for*” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “*for*” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”).

There appears to be no nexus between the intended use of the preamble and the body of the claim in order to realize the functionality intended. The “the retrieving numerical expression in a natural language” appear to be missing of the body of the claim.

11. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention. The optionally recited “document OR numerical expression” starting with line 7, allows for one choice and to proceed

with the case accordingly. Thus, making the second non-elected option never having to take place.

Claims 2-6 are dependent on claim 1 and thus carry the same deficiency.

*Allowable Subject Matter*

12. Although no rejections in view of prior art are made with regards to the claims, no claims in this application will be indicated as allowable until after a response to this action has been reviewed, as to the fact that certain changes may not produce allowable claims.

*Closest prior art of Record*

13. Mills (U.S. Patent No. 6,466,940) teaches building Web pages from extracted numerical attributes.

Hsieh (U.S. Patent No. 7,003,792 B1) teaches storing records in a database using conversion table for non-indexed data.

Snyder (U.S. Patent No. 6,643,641 B1) teaches retrieving numerical results.

Talib et al. (U.S. Pub. No. 2005/0216447) teaches enabling efficient retrieval of documents from a document archive.

IST 1999-11438: MUCHMORE Document Specification on UMLS. Retrieved from Google Search 6/1/2006.

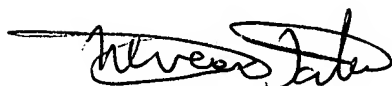
Stephane Lavirotte & Loic Pottier. Optical Formula Recognition. France. IEEE 1997.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neveen Abel-Jalil  
June 24, 2006